

**REMARKS**

Claims 1-10 are pending in this application. By this Amendment, claims 1 and 2 are amended, as is the specification. The amendments introduce no new matter. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

The Office Action, on page 2, objects to the specification for an informality. The specification is amended to obviate the objection. Withdrawal of the objection to the specification is respectfully requested.

The Office Action, on page 2, rejects claims 2 and 3 under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, a feature recited in claim 2 is indicated as lacking sufficient antecedent basis. Claim 2 is amended to obviate the rejection.

Accordingly, reconsideration and withdrawal of the rejection of claims 2 and 3 under 35 U.S.C. §112, second paragraph, as being indefinite are respectfully requested.

The Office Action, on page 2, rejects claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,648,876 to Murakami in view of U.S. Patent No. 4,729,372 to L'Esperance, Jr. This rejection is respectfully traversed.

The Office Action, on page 3, admits "Murakami does not disclose the use of an attenuation means." Rather, the Office Action relies on L'Esperance, Jr., in its disclosure of what the Office Action states is the use of a variable attenuation disk to alter the beam distribution of a laser ophthalmic system, as allegedly disclosing a feature that the Office Action implies corresponds to the beam-attenuating member recited in the pending claims. The Office Action concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the blocked apertures taught by L'Esperance, Jr., in the laser device of Murakami "as an alternative equivalent for modifying the energy distribution of the beam delivered to an eye."

Claim 1 recites, among other features, a beam-attenuating member having a transmittance property that a transmittance is lower in a center portion than in a peripheral portion, the beam-attenuating member being placed in a position on the optical axis where the beam-attenuating member is unconjugated with the treatment part and where an on-axis luminous flux and an off-axis luminous flux of the treatment beam emerging from the exit end of the optical fiber pass through the beam-attenuating member at different ratios.

The analysis of the Office Action regarding the features allegedly corresponding to the claimed beam-attenuating member necessarily fails for at least two reasons.

First, the "different masking disk 62" of L'Esperance (see Fig. 11 and col. 6, line 62) does not correspond to the claimed beam attenuating member. Rather, the masking disk 62 more correctly corresponds to, for example, a rotatable support board upon which filters are attached, the rotatable support board being placed adjacent to the exit end face of the optical fiber having to be rotated in order to produce different intensity distributions according to spot sizes as is discussed in the Description of the Related Art in the paragraphs beginning at page 2, line 2 and page 2, line 10, of Applicant's disclosure. An objective of the claimed beam-attenuating member is to overcome shortfalls in the application of such a rotating board in a laser treatment apparatus. Based at least on this disclosure, the masking disk 62 of L'Esperance, Jr., cannot reasonably be considered to have suggested the subject matter of the beam-attenuating member as recited in the pending claims. The Office Action makes no attempt, other than generally, to analyze how the masking disk 62 of L'Esperance, Jr. can reasonably be considered to suggest all of the detailed features quoted above regarding the beam-attenuating member as recited in claim 1 of this application.

Second, one of ordinary skill in the art would not have combined Murakami and L'Esperance, Jr. in the manner suggested by the Office Action and the purported motivation to combine the references is insufficient. Murakami is directed to a photocoagulation apparatus

adapted to an irradiated treatment part of the fundus of a patient's eye for the laser beam. Among the objectives of Murakami is to control an intensity distribution in the central portion of the laser beam to attempt to provide uniform photocoagulation over the treatment part (see, e.g., col. 1, lines 39-64). L'Esperance, Jr., is directed at controlled ablation of the cornea using ultraviolet laser radiation for changing the refractive power of a patient's eye. The invention of L'Esperance, Jr. includes in certain embodiments a mass for blocking the central part of luminous flux to prevent the luminous flux from reaching the central part of the cornea thereby ablating the cornea (see, e.g., col. 1, line 66 - col. 2, line 44). As noted above, the subject matter of these claims is directed to doing away with the type of rotatable support board used in L'Esperance, Jr. These facts alone or in the combination, support a conclusion that one of ordinary skill in the art would not have been motivated to combine the references in the manner suggested in the Office Action. In other words, in seeking to improve on prior art techniques for beam-attenuation in a device such as that disclosed in Murakami one of ordinary skill would not have been motivated to revert to known procedures and/or processes with their attendant shortfalls, and/or to apply teachings directed at solving a completely different problem.

Further, the alleged motivation of the Office Action fails to meet the standard required by the Patent Office for a showing of objective evidence of a motivation, suggestion or teaching in the applied prior art references to make the purported combination. MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *See also In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that the rejection of at least

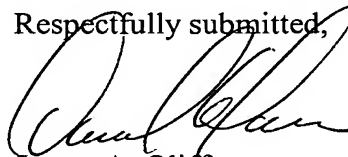
independent claim 1 is improper in view of at least MPEP §2143.01 because the Office Action lacks the required specific evidence of a teaching, suggestion or motivation in the prior art for one of ordinary skill to combine the references. Given the specific disclosure of Murakami, in fact, one of ordinary skill in the art would have likely discounted any device for beam-attenuation comprising a rotatable board such as that allegedly disclosed in L'Esperance, Jr.

For at least the above reasons, the applied prior art references, Murakami and L'Esperance, Jr., are not combinable in the manner suggested by the Office Action, and any permissible combination of the applied prior art references would not have suggested to one of ordinary skill in the art the combination of all of the features recited in at least independent claim 1. Further, claims 2-10 are also neither taught, nor would they have been suggested, by any permissible combination of the applied prior art references for at least the respective dependence of these claims directly or indirectly on independent claim 1, as well as for the separately patentable subject matter that each of these claims recites.

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-10 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,



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